

## REMARKS

Claims 1-24 and 26-38 are pending in the application. Claims 1-24, 26-29, and 31 have been amended more clearly to recite the novel features of the present invention and/or more particularly to point out and distinctly claim the present invention. Claims 32-38 have been added to recite additional novel features of the present invention. Claims 1, 16, 27, 28, 29, 31, and 38 are independent.

Reconsideration and withdrawal of the outstanding objections and rejections are respectfully solicited in view of the foregoing amendments and the following remarks.

The Examiner objects to the Declaration because it appears that at least one full given of Applicant James Robert Matcalfe, is not present either in the signature or elsewhere in the paper. The Examiner states that the application will not be passed to issue until the omitted name has been supplied or at least a statement has been supplied over the Applicant's signature setting forth that the name as signed is the actual full name of Applicant, James Robert Matcalfe. To support this requirement, the Examiner cites MPEP § 605.04.

Applicants respectfully traverse this objection. Nowhere does MPEP § 605.04 require Applicant to confirm that a signature supplied on a declaration is the actual full name of the Applicant. Rather, § 605.04(b) merely requires that each inventor be identified by a full name including a family name and at least one given name without abbreviation together with any other given name or initial in the oath or declaration.

This Applicants have done. Applicants have identified themselves by printing the name "James Robert Matcalfe" as the full name of the second joint inventor on the Declaration.

MPEP § 605.04(b) also states that in an application where the name is typewritten with a middle name or initial, but the signature is without such middle name or initial, the typewritten version of the name will be used.

Nowhere else does MPEP § 605.04 address this issue of conforming the signature to the printed name on the declaration. Thus, it is submitted that the Examiner is not entitled to object to the declaration on this basis. Therefore, Applicants respectfully request that the rejection be withdrawn.

The Abstract of the application has been objected to for the use of legal phraseology. In response, the Abstract has been amended to eliminate all such legal phraseology.

Claims 8, 12, 16, 20, and 21 have been rejected under 35 U.S.C. § 112, second paragraph.

In response, while not conceding the propriety of the rejection under 35 U.S.C. § 112, second paragraph, Claims 8, 12, 16, 20, and 21 have been amended to address the points raised by the Examiner. Applicants submit that these claims now even more clearly satisfy 35 U.S.C. § 112, second paragraph.

Claims 1-5, 13, 14, 16, 17, 22, 23, and 25-31 have been rejected under 35 U.S.C. § 102(b) over the patent to Judson. In addition, the other claims have been rejected over the patent to Judson in view of one or more of the patents to Hayashi, et al., Yoda, and the citations to Brown and the Borland Quattro Pro User's Guide.

In response, while not conceding the propriety of the rejections under 35 U.S.C. § 102 and § 103, independent Claims 1, 16, 27, 28, 29, and 31 have been amended. Applicants submit that as amended, these claims are allowable for the following reasons.

As indicated in the background portion of the present application, the growth of the Internet has afforded the rapid and economical access to electronic information using well-known-browser-Internet software. But, documents uncovered by Internet browsers are generally configured for screen viewing and not necessarily for printing. As a result, Internet browsers have the capacity for printing only one web page or web location at a time. In order to print information from a number of web pages or web locations, the user must access each of those pages in turn, and during each accessing operation, the user must manually initiate a printing operation. Thus, printing pages from several web sites requires many manual print operations. This is time consuming and cumbersome.

To solve this problem, the present invention provides an application package to record web pages and web sites accessed by a user accesses and to automatically form them into a displayed list of printable documents. The user can then select items on the displayed list for printing. The application package then formats the contents of each selected web page into a single printer document which can be viewed by the user. After the user is satisfied that the single printable document contains all that is desired for printing, the user then initiates a single, manual printing operation in the application package, (not the browser) to effect printing of those web pages in a convenient and condensed form. As a result, the user is free to then browse and roam web pages at leisure without the need to print each desired web page as it is encountered.

In other words, the user need only to perform a single manual printing operation in order to print plural web pages from web sites.

Accordingly, independent Claim 1 has been amended to recite that it relates to a method for forming a printable document by collating a plurality of hyper-text documents.

This method comprises the steps of monitoring a user's access patterns to the hyper-text documents, accessing the hyper-text documents including structure information of the accessed hyper-text documents, compiling a list of the hyper-text documents using the structure information, and formatting the list into the printable document comprising each hyper-text document specified in the list.

In contrast, the Judson patent merely relates to a method by which a previously visited web site can be temporarily displayed to a user from a cached version of that web site while a current version of the web site is downloaded and subsequently displayed. By this arrangement, the apparent fetching and idle time of the browser is reduced, thereby apparently optimizing the user's time for traversing the Internet. As a result, the web-document formatting and displaying is for the purpose of displaying documents, not printing documents.

Thus, this patent does not disclose or suggest a method for forming a printable document by collating a plurality of hyper-text documents as recited by amended Claim 1. Therefore, this patent also does not disclose or suggest the steps of compiling a list of the hyper-text documents using the structure information and formatting the list into the printable document comprising each hyper-text document specified by the list, as also recited by amended Claim 1.

The failure of this patent to disclose or suggest at these three features of amended Claim 1 proves fatal to establishing anticipation of Claim 1, since MPEP 2131 states:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

In addition, failure of this reference to disclose or suggest at least these three features of Claim 1 proves fatal to establishing a prime facie case of obviousness against Claim 1, since MPEP §2142, requires that:

To establish a prima facie case of obviousness... the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Thus, Claim 1 is allowable over the Judson patent.

Since independent Claims 16, 27, 28, 29, 31, and 38 recite similar features, they are allowable for similar reasons.

Thus, the Judson patent does not disclose or suggest a method of forming a printable document by collating a plurality of hyper-text documents comprising the step of collating and formatting accessed hyper-text documents using structure information and at least a predetermined printable document format to form a printable document in which the accessed hyper-text documents are contiguously arranged therein over at least one printable page, as recited by amended Claim 16.

The Judson patent, therefore, also does not disclose or suggest a computer implemented method for forming a printable document by collating a plurality of documents obtained from a plurality of sources comprising the step of collating selected documents according to a predetermined order of collating to form a printable document, the collating comprising arranging at least one display page according to a size of each selected document based upon corresponding structure information wherein the printable document is reproducible by at least by printing, as recited by amended Claim 27.

Consequently, the Judson patent also does not disclose or suggest means for monitoring access to documents via a resource locator and compiling a list of accessed

ones of the documents, the list including corresponding links and structure information pertaining to each accessed document, and means for collating the list into a selected order and for formatting the accessed documents within the list into a single printable document having at least components corresponding to the accessed documents arranged in the selected order, as recited by amended Claim 28.

Thus, the Judson patent also does not disclose or suggest a computer readable medium including instruction modules comprising a collating module for collating selective ones of documents from a compiled list into a single printable document in which each selected document is formatted according to structure information derived from monitoring browsing operations and a printing module for causing a printing of the single printable document thereby causing hard copy reproduction of the single printable document and the selected documents, as recited by amended Claim 29.

As a result, the Judson patent also does not disclose or suggest a computer program product having a computer readable medium having a computer program recorded thereon for forming a printable document by collating a plurality of hyper-text documents, comprising means for compiling a list of selected ones of the hyper-text documents using structure information of the documents and means for formatting the list into a printable document comprising the selected ones of the accessed hyper-text documents, as recited by amended Claim 31.

Finally, the Judson patent does not disclose or suggest a computer implemented program for forming a single printable document by collating a plurality of hyper-text document, the method comprising the steps of fetching hyper-text documents accessed by a first application including corresponding structure information thereof and creating a single

formatted printable document version of the accessed hyper-text documents, as recited by new independent Claim 38.

The dependent claims are allowable for the reasons given for the independent claims and because they recite features which are patentable in their own right. Individual consideration of the dependent claims is respectfully solicited.

For example, independent Claim 3 recites that the printable document is updated upon new hyper-text pages being accessed. Such an updating is illustrated, for example, in Figure 5, which clearly indicates the window shown therein for the printable-document formatting and updating feature of Claim 3 is separate from the web browser application window. Since the Judson patent relates to the use of a browser window, it does not disclose or suggest this feature of Claim 3.

In addition, Claim 6 recites that the steps of Claim 1 are performed substantially in synchronism to the user's access to the hyper-text documents. Since the Judson patent does not disclose or suggest the steps recited in Claim 1, as noted above, the Judson patent can not disclose or suggest the performing of these steps substantially in synchronism with the user's access with the hyper-text document as recited by Claim 6.

Independent Claim 7 recites that step (d) comprises the step of formatting the printable document for multiple column page printing of a printer output device, while Claim 8 recites that the printable document comprises a plurality of hyper-text documents on at least one page of the printable document. In contrast, neither the Hayashi patent nor the Judson patent disclose such formatting of a printable document based on hyper-text documents obtained by using a user's access patterns, as recited by Claim 1, 7, and 8. Rather, the Judson patent merely relates to the display of documents on a screen, while the Hayashi patent merely relates

to the formatting of document using a multiple column layout facility without any reference to Internet browsing. Moreover, there is no suggestion for combining the references to produce the invention recited in Claims 7 and 8, and it would be difficult to combine the references to produce the invention the Claims 7 and 8, since the Hayashi patent relies for its formatting upon knowing the format of the document in advance, as is often the case in desk top publishing and word processing packages, while documents accessed from the world wide web are not known to the user at the time they are accessed.

The Yoda patent, which was used to reject a number of dependent claims, merely discloses an arrangement by which a list of hyper-links is created from a single source document. These links are then used to obtain access information which is separately printed in linear form. In addition, this patent discloses creating an index to printed based upon hyper-link lists so that duplicate links within the list can be eliminated by preventing the printing of duplicate of information. But this patent, like the Judson patent, does not or suggest the monitoring of the user's access patterns to create a list of hyper-text documents and formatting a list into a printable document as recited by Claim 1, for example.

Dependent Claims 15 and 24 recite the steps of displaying the printable document in preview form during access to the hyper-text documents or while the user is accessing the hyper-text documents. In contrast, the cited Borland Guide and Mark Brown citation merely disclose a conventional print screen preview button. They do not disclose or suggest the formatting of a printable document from monitored or accessed hyper-text documents, as recited by these claims.

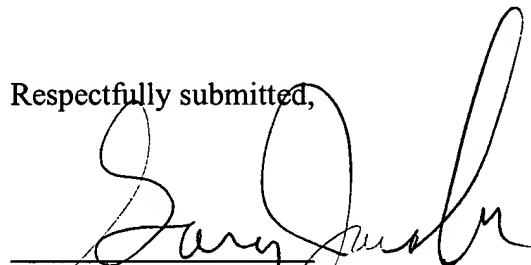
The other art of record is also not understood to disclose or suggest the inventive concept of the present invention as defined by the claims.



In view of the above amendments and remarks, the claims are now in allowable form.  
Therefore, early passage to issue is respectfully solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

  
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